Applicant: ERNEST W. MOODY

Serial No.: 10/621,768 Art Unit: 3712

Filed: July 16, 2003 Examiner: Collins, D.R.

For: POKER GAME IN WHICH PLAYER CAN PLAY ON WITH A HIGHER PAY TABLE

MAIL STOP APPEAL BRIEF -- PATENTS
Commissioner for Patents
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

APPEAL BRIEF

I hereby certify that this correspondence is being deposited with the United States Postal Service as on this date January 12, 2005 in an envelope as "Express Mail Post Office to Addressee" Mailing Label No. ED002843375US addressed to: MAIL STOP APPEAL BRIEF -- PATENTS, COMMISSIONER FOR PATENTS, PO BOX 1450, ALEXANDRIA, VA 22313-1450.

Ernest W. Moody
Applicant(s)

Signature

January 12, 2005
Date of Signature

01/18/2005 MBERHE 00000100 10621768
01 FC:2402 250.00 OP

1. REAL PARTY IN INTEREST

This application has not yet been assigned, but it is under contract to be assigned to Action Gaming, Inc., a Nevada corporation.

2. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

3. STATUS OF CLAIMS

Claims 1-4 are pending in this application. Claims 1-4 stand TWICE rejected.

4. STATUS OF AMENDMENTS

There are no Amendments after the second rejection of Claims 1-4.

5. SUMMARY OF THE CLAIMED SUBJECT MATTER

Appellant's invention relates to methods of playing a card game.

Claim 1 is the only independent claim. The method begins with

providing a first pay table and the player making a wager to play the card game. [Specification page **15**: lines **9-11; 16:6-9; Table 3**]. An initial five card hand is displayed to the player. **[15:13-14; Figure 1,** reference **#60]**. The player holds, discards and draws replacement cards resulting in a final five card hand. **[17:1-16]**. The poker hand ranking of the final five card hand is determined. **[17:16-17; Figure 2, #62]**. If the player has a winning poker hand, the player receives an award. **[17:18-19]**.

The player is then allowed to parlay at least a portion of this award into a second round of play in which as second pay table is used that has a different overall game return that the first pay table. **[18:1-8; Table 4; Figures 3 and 4, #71-#76]**.

6. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-4 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6419578 view of Gajor (6443456).

7. ARGUMENTS

A. Rejection of Claims 1-4

Claims 1-4 stand rejected under the judicially-created doctrine of obviousness-type double-patenting over Claims 1-24 of U.S. Patent No. 6419578 in view of Gajor (6443456).

Appellant submits that this rejection is not proper. The Examiner takes the position that "the patented and pending claims set forth the same invention of substantially the same scope except the invention patented claims 1-24 lack the parlay feature." The Examiner then argues that the reference to Gajor teaches a parlay feature to provide player with additional wagering options.

Notwithstanding the Examiner's misstatement of the law of obviousness-type double-patenting [see In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970)], the inventions set out in Claims 1-4 of the instant application are substantially different than the inventions set out in Claims 1-24 of the '578 patent. Furthermore, the question of obviousness-type patenting depends on the claimed subject matter of the earlier '578 patent claims 1-24 as compared to the claimed subject matter of Claims 1-4 of the instant application.

The present inventions as set out in Claims 1-4 are directed at providing a first pay table and playing a first hand of video poker. If the final poker hand after the hold and draw step results in a winning combination, the player may then parlay all or some of his winnings into a second round of play using a second pay table that has a different overall game return than the first pay table.

Claims 1-24 of the '578 patent claim various inventions related to awarding the player various bonus events based on the preselected arrangement of cards of the player's initial five card hand. There is nothing in the claimed inventions of Claims 1-24 of the '578 that make any bonus event determinations based on the final five card hand of the player. Any and all of Claims 1-24 of the '578 patent first deal five cards to the player. If a preselected arrangement of cards appears in these first five cards, then the player is offered various options (such a getting a replacement pay table, or getting a second hand or getting a bonus round event). The Examiner simply ignores this step of Claims 1-24 of the '578 patent in her double patenting analysis. She offers no factual basis that this step can be deleted from any

and all of Claims 1-24 of the '578 patent.

There is also no basis in the claimed inventions of Claims 1-24 of the '578 patent for teaching or suggesting that the various methods of play set out in Claims 1-24 of the '578 patent could be modified to use the player's final five card hand to determine whether various bonus events may be awarded to the player.

Additionally, Claims 1-4 of the present invention specify that the bonus event is a second round of play using a pay table with a different overall game return than the pay table used in the first round of play and this occurs only if the player parlays at least some of his award from the first round of play into the second round of play.

There is nothing to this effect in Claims 1-24 of the '578 patent. The Examiner appears to note this shortcoming of Claims 1-24 of the '578 patent since the Examiner relies on Gajor for this purported teaching.

The patent to Gajor discloses a video poker game in which multiple hands are played. The player makes a wager for each pay line the player wishes to play. The player also makes what Gajor calls a "parlay" wager which only results in a payout if the

player has multiple winning hands in a single round of play.

To a person of ordinary skill in the poker art, Gajor has misused the term "parlay". A traditional parlay occurs if the player uses his winnings from a first wager to make a second wager. For example, in horse racing, if the player wins on the first race, he then can "parlay" his winnings into a wager on the second race. Likewise, if the player is betting on two footballs games played on consecutive days or the afternoon game and the evening game. Many sports books will handle the parlay feature automatically by merely allocating any winnings from the first event into the wager on the second event. However, the traditional use of the term "parlay" requires a winning first event to provide the funds for the wager on the second event.

In the Gajor disclosure, his "parlay" wager is simply an additional wager on a separate outcome that may occur in the first event. Even if it would have been obvious to add this additional wager of Gajor to the methods of Claims 1-24 of the '578 patent, Gajor's additional wager does not meet the limitation of Claims 1-4 of the instant application such that at least a portion of the winning from the first round of play are parlayed into a second

round of play using a pay table that has a different overall game return than the first pay table.

Since the Examiner has not made a prima facie case that it would have been obvious to modify any of the methods of play of Claims 1-24 of the '578 patent to use the player's final five card hand to determine whether various bonus events may be awarded to the player, the rejection of Claims 1-4 under the judicially-created doctrine of obviousness-type double patenting is not proper and should be withdrawn.

Also, since the Examiner has not made a prima facie case that it would have been obvious to modify any of the methods of play of Claims 1-24 of the '578 patent to use at least a portion of the player's winnings from the first round of play in a second round of play, the rejection of Claims 1-4 under the judicially-created doctrine of obviousness-type double patenting is not proper and should be withdrawn.

And also, since the Examiner has not made a prima facie case that it would have been obvious to modify any of the methods of play of Claims 1-24 of the '578 patent to use a second pay table in the second round of play that has a different overall game

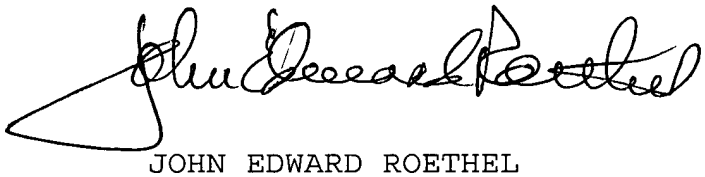
return than the pay table used in the first round of play, the rejection of Claims 1-4 under the judicially-created doctrine of obviousness-type double patenting is not proper and should be withdrawn.

8. CONCLUSION

Appellant submits that Claims 1-4 have been improperly rejected by the Examiner under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-24 of U.S. Patent No. 6419578 view of Gajor (6443456).

Appellant respectfully requests that the Board of Appeals reverse the Examiner's rejections of Claims 1-4 and remand this application to the Examiner for further action consisting of a Notice of Allowance.

Respectfully submitted,



JOHN EDWARD ROETHEL
Attorney for Appellants
Registration No. 28,372

2290 S. Jones Blvd., #100
Las Vegas, NV 89146
Phone: (702) 364-1190

CLAIMS APPENDIX

Claim 1. A method of playing a card game comprising:

a) providing a first pay table and having a player make a wager to participate in the card game;

b) playing a first round of play of the card game by displaying a first initial hand of at least five cards all face up to the player;

c) the player selecting none, one or more of the face up cards from the first initial hand as cards to be held, discarding the unselected cards and displaying replacement cards for the discarded cards resulting in a first final hand;

d) determining the poker hand ranking of the first final hand;

e) if the poker hand ranking of the first final hand results in a winning hand combination, awarding the player a predetermined amount based on the amount of the wager; and

f) allowing the player to either collect the award or to parlay the at least a portion of the award into a second round of play of the game in which a second pay table is used that has a different overall game return than the first pay table.

Claim 2. The method of Claim 1 in which the second pay table has a higher overall game return than the first pay table.

Claim 3. The method of Claim 1 in which the second round of play uses multiple hands.

Claim 4. The method of Claim 3 in which the award won in the first round of play is allocated among the multiple hands.

EVIDENCE APPENDIX

None

RELATED PROCEEDINGS APPENDIX

None